Application No: 10/014,234
Attorney's Docket No: US 010607

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks. Currently, claims 1 – 31 and 34 – 36 are pending in the present application of which claims 1, 27 and 34 are independent.

Claims 1 -6, 8 – 10, 13, 14, 16 – 19, 22 – 24, 27, 29 and 34 – 36 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Chen et al. (EP 0952737). Claims 7, 20, 21, 28, 30 and 31 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chen in view of Basu et al. (U.S. Patent Number 6,594,629). Claim 11 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chen in view of Notargiacomo et al. (U.S. Patent Application Number 2003/0014422). Claims 12 and 15 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chen in view of Errico (U.S. Patent Application Number 2003/0061610). Claims 25 and 26 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chen in view of Hoffberg (U.S. Patent Application Number 2002/0151992). The above rejections are respectfully traversed for at least the reasons set forth below.

Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485

- 10 -

(Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

> Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1 -6, 8 – 10, 13, 14, 16 – 19, 22 – 24, 27, 29 and 34 – 36 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by the disclosure contained in Chen. This rejection is respectfully traversed because the claimed invention as set forth in claims 1, 27, 34, and the claims that depend therefrom are patentably distinguishable over Chen.

Chen discloses a Profile Subsystem (which contains a profile of profile items in a database of information of interest to a viewer of a TV) that controls selection of one or more of the segments of information if the segments themselves contain one or more profile items. In addition, an Information Processor processes the received information streams and segments to identify streams of interest to the viewers. In this case, the audio segments are processed by any one or more of the following methods: using speech recognition to generate a searchable transcript for key word searching, audio processing to determine the type of audio including any one or more of the following: speech, music, noise, sounds, and speaker identification processing to determine the identity of a particular speaker. The video segments are processed by any one or more of the following methods: using image processing to identify a searchable person, place,

- 11 -

thing, action, or event. The data segments are processed by any one or more of the following methods: using text processing to generate a searchable hit list of one or more words. The Information Processor generates identifiers from the processed segments and the identifiers are used by the Profile Subsystem to control the selection of information streams.

Claims 1, 27 and 34 recite a system that uses a knowledge base comprising a plurality of known relationships. Chen fails to disclose the knowledge base recited in claims 1, 27 and 34. Specifically, Chen fails to disclose a set of known relationships that are used to search content. Claims 1, 27 and 34 each recite a knowledge base that draws relationships between criteria inputted by a user of the system and known relationships that are useful for searching content. The content analyzer processes the user criteria along with the known relationships from the knowledge base in order to search content from an external source and retrieve information. Chen does not disclose the use of known relationships to search content. The Profile Subsystem disclosed in Chen is a collection of predetermined profiles comprising a number of fields. The fields are broad categories of available information. No aspect of Chen's invention allows the user to search an external source of content. The Profile Subsystem is only used to select between the already-available information streams and does not retrieve information from external sources of content nor does it encompass a set of known relationships.

Accordingly, Chen fails to teach all of the features contained in claims 1, 27 and 34, and thus, these claims are believed to be allowable. Claims 2 -6, 8 – 10, 13, 14, 16 – 19 and 22 – 24 depend upon allowable claim 1 and claims 29, 35 and 36 depend upon allowable claim 27 and are also allowable at least by virtue of their dependencies. The Examiner is therefore

- 12 -

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respectfully requested to withdraw the rejection of claims 1 -6, 8 – 10, 13, 14, 16 – 19, 22 – 24, 27, 29, and 34 – 36.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 7, 20, 21 28, 30 and 31 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chen in view of Basu. The Applicants submit that claims 1 and 27 are not anticipated by Chen. In addition, the Office Action does not rely upon Basu to make up for the deficiencies in Chen with respect to claims 1 and 27. Therefore, claims 7, 20 and 21 which depend from claim 1 and claims 28, 30 and 31 which depend from claim 27 are allowable at least

- 13 -

by virtue of their dependency. The Examiner is therefore respectfully requested to withdraw the rejection of claims 7, 20, 21 28, 30 and 31.

Claim 11 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chen in view of Notargiacomo. The Applicants submit that claim 1 is not anticipated by Chen. In addition, the Office Action does not rely upon Notargiacomo to make up for the deficiencies in Chen with respect to claim 1. Therefore, claim 11 which depends from claim 1 is allowable at least by virtue of its dependency. The Examiner is therefore respectfully requested to withdraw the rejection of claim 11.

Claims 12 and 15 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chen in view of Errico. The Applicants submit that claim 1 is not anticipated by Chen. In addition, the Office Action does not rely upon Errico to make up for the deficiencies in Chen with respect to claim 1. Therefore, claims 12 and 15 which depend from claim 1 are allowable at least by virtue of their dependency. The Examiner is therefore respectfully requested to withdraw the rejection of claims 12 and 15.

Claims 25 and 26 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chen in view of Hoffberg. The Applicants submit that claim 1 is not anticipated by Chen. In addition, the Office Action does not rely upon Hoffberg to make up for the deficiencies in Chen with respect to claim 1. Therefore, claims 25 and 26 which depend from claim 1 are allowable at least by virtue of their dependency. The Examiner is therefore respectfully requested to withdraw the rejection of claims 25 and 26.

- 14 -

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Application No: 10/014,234
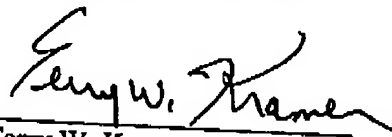Attorney's Docket No: US 010607

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

While we believe that the instant amendment places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner telephone the undersigned attorney in order to expeditiously resolve any outstanding issues.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
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- 15 -